

## REMARKS

Claims 1 - 27 remain pending. Claims 28 and 29 have been added.

### **Drawings**

The drawings were objected to under 37 CFR 1.83(a). Applicant submits that folder 30, as illustrated in FIGS. 7 and 8, and described in the specification at page 7, lines 17-20, may be a postage paid mail item in its flat form. When empty and flat, folder 30 could properly be sent through the mail. Reconsideration of this objection is requested.

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(4) because reference character "6" was used to designate both the bottom member and drawer, reference character "30" was used to designate both "folder" and "divider," and reference character "10" was used to designate "sorting device" and "Soderstrom device" and "frame." Correction has been made to relevant portions of the specification and, as a result, reconsideration of these drawing objections is requested.

The drawings were objected to as failing to comply with 37 C.F.R. 1.83(a) because they failed to show element 46, "fold line" [page 7, line 1], as described in the specification. A proposed drawing correction of FIG. 4 is included with this reply. No new matter is added by this correction.

### **Claim Rejection: Rejection under 35 U.S.C. §112**

Claims 1 and 7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 7 have been amended to correct this oversight.

Claims 1, 2, 7 and 8 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 7 have been amended to correct this oversight.

BEST AVAILABLE COPY

**Claim Rejection: Rejection under 35 U.S.C. §103**

Claims 1, 3-7, 9-11 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ryan '306 in view of Schreyer '819 and further in view of D'Elia '325. It is submitted that the rejections based on Ryan, Schreyer and D'Elia are improper as the Examiner has failed to establish a prima facie case of obviousness as the prior art references, even if a proper combination, would not teach or suggest all of the claim limitations. Reconsideration of these rejections is requested.

Regarding claim 1, it is submitted that the combination of Ryan, Schreyer and D'Elia, even if proper, would fail to yield the present invention. The combination would fail to teach or suggest all of the claim limitations. For example, the folder device of the present invention has forward edges of the first and second sides which are differently configured. Applicant disagrees with the statement that the limitation of the sides of the folder being "differently configured" would have been an obvious matter of design choice.

Regarding claims 1 and 7, it is submitted that the combination of Ryan, Schreyer and D'Elia, even if proper, would fail to yield the present invention. The combination would fail to teach or suggest all of the claim limitations. For example, the folder device of the present invention has sides which are differently configured so that the forward edges of the sides are at different heights relative to the leading edges of the associated partition elements. Applicant disagrees that it would have been an obvious matter of design choice to make the sides "differently configured." Additionally, applicant disagrees that "applicant has not disclosed that by making the sides in a particular way would solve any stated problem..." To the contrary, the limitation of the sides of the folder being "differently configured" addresses the problem of efficiency in mail placement within the folder. Using a device according to present invention, an individual sorting mail is able to efficiently place mail into the folder 30 with a left-to-right hand motion of the sorter's hand passing over the reveal structure 40 and brought into contact with the opposite side wall of the sheet element 34 at which point the mail is released into the associated folder 30. Page 6, lines 22-25. The reduced height of one of the folder sides relative to the partitions facilitates centering of the mail within the folder prior to release. The sorting process is improved since the mail can be quickly released into the folder and not outside of the folder (and between the partitions). In the illustrated embodiment of FIG. 5, as the individual's hand moves

**BEST AVAILABLE COPY**

in a left-to-right motion it makes primary contact with the taller of the folder panels. Upon contact with the taller panel the mail is always released into folder center so long as the mail is on the inner surface of the tall panel. In comparison, if the folder side panels were similarly configured (e.g., equal height), the sorting process would be more cumbersome as the sorter would have to determine which side of the folder panel is the inner side. The invention would not perform equally well if a folder, such as disclosed in D'Elia, were used. Reconsideration of this rejection is requested.

Regarding claims 4 and 10, it is submitted that the combination of Ryan, Schreyer and D'Elia, even if proper, would fail to yield the present invention. The combination would fail to teach or suggest the folder being a postage paid mail item.

Regarding claims 5 and 11, the combination would fail to teach or suggest a splay structure which functions to retain the folder in an open manner when inserted into a compartment of a conventional or Soderstrom sorting device. Applicant disagrees with the statement that "applicant has admitted that at least alternative splay structures are known." Office action, Page 6, lines 4-5. The specification suggests only that those skilled in the art, with the teachings of applicant's disclosure, may appreciate alternative embodiments of a splay structure. None of the cited references disclose a splay structure nor does the context of the cited applicant's statement suggest that these are well known. Schreyer shows folders 12, 12 to provide a flat bottom 20 but makes no mention of a splay to cause one or both panels to diverge. D'Elia shows gusset folds 21, 22 at the side edges but they would provide an opposite (i.e. flattening) effect.

Claims 3-6, 9-11 and 12 are dependent claims based on claims 1 and 7. In view of the arguments presented with reference to claims 1 and 7 above, it is submitted that these claims are in condition for allowance.

Claims 13-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ryan '306 in view of Schreyer '819 and further in view of D'Elia '325. It is submitted that the rejections based on Ryan, Schreyer and D'Elia are improper as the Examiner has failed to establish a prima facie case of obviousness as the prior art references, even if a proper combination, would not teach or suggest all of the claim limitations. Reconsideration of these rejections is requested.

**BEST AVAILABLE COPY**

Regarding claim 13, it is submitted that the combination of Ryan, Schreyer and D'Elia, even if proper, would fail to yield the present invention. The combination would fail to teach or suggest the method for creating a delivery point package as claimed. For example, the combination of Ryan, Schreyer and D'Elia would fail to teach the steps of sorting mail items, placing a folder with each subgrouping of mail, accessing each folder and associated mail, and inverting the folder to capture associated mail and create a delivery point package. Applicant disagrees with the statement that "the step of inverting the folder around the mail rather than placing the mail in the open folder (as disclosed in D'Elia) appears to be a matter of design choice, since the applicant has not disclosed that by placing the mail in the folder in a particular way would solve any stated problems or is for any particular purpose and it appears that the invention would perform equally well with the present teaching." Office action, page 7, lines 11-15. The step of inverting the folder around mail of claim 13 is for the purpose of defining a delivery point package for mail. "The delivery point package 50 provides an efficient and effective mail item capture device which facilitates the delivery process by potentially decreasing the mail sorting process and reducing the possibility of lost or separated mail items." Page 8, lines 2-7. Another benefit of the method of creating delivery point packages of claim 13 is that no specific folder holding device (e.g. frame) is required (i.e. it is not necessary to hold the folders open while mail is placed into the open folder).

Regarding claims 18 -20, the combination of Ryan, Schreyer and D'Elia fail to teach or suggest the step of sorting postage paid mail items which contain a plurality of folder devices. The use of a folder as a postage paid mail item is not taught or suggested by the cited references.

Regarding claims 21 - 27, the combination of Ryan, Schreyer and D'Elia fail to teach or suggest the steps of inverting a folder around mail items, placing the inverted folder (containing mail) into a sorting machine, and subsequently adding more mail to the folders.

Regarding claim 21, the combination of Ryan, Schreyer and D'Elia would fail to teach or suggest the method for creating a delivery point package as claimed. For example, the combination of Ryan, Schreyer and D'Elia would fail to teach the steps of sorting mail items, associating a folder with each unique indicia, inverting the folder around the mail items to

capture the associated mail, placing the inverted folder into a sorting device, and inserting additional mail items into the inverted folder.

Regarding claim 26, the combination of Ryan, Schreyer and D'Elia would fail to teach or suggest the method for creating a delivery point package as claimed. For example, the combination of Ryan, Schreyer and D'Elia would fail to teach the steps of sorting mail items and folders, inverting the folder around the mail items to capture the associated mail items, placing the inverted folder into a sorting device, and inserting additional mail items into the inverted folder.

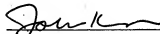
The Examiner is simply engaging in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps, an activity the Federal Circuit has repeatedly indicated as improper. *In re Gorman*, 933 F.2d 982, 19 USPQ2d 1885 (Fed. Cir. 1991). There must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 USPQ 90 (Fed. Cir. 1985). The Examiner has not established a prima facie case of obviousness by failing to provide the motivation or reasoning as to why the combination of references is proper.

We submit that the present invention as currently claimed is not made obvious by the combination of Ryan, Schreyer and D'Elia. Consequently, we respectfully request that the rejections based thereon be withdrawn.

Please direct any questions regarding this application to John Klos at (612) 321-2806.

Respectfully submitted,  
Lance E. Anderson, by his attorneys,

Dated: February 19, 2004

  
John F. Klos, Esq.  
Registration No. 37,162  
Fulbright & Jaworski L.L.P.  
80 South Eighth Street  
Minneapolis, MN 55402-4320  
Telephone: (612) 321-2806